

### **REMARKS**

Claims 1-15 are pending in this application. Claims 1, 3, 9-11 and 13 are independent. In light of the remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 11-12 and 14 under 35 U.S.C. §102(b) as being anticipated by Russell et al. (US Patent 6,703, 570) (hereinafter, "Russell"). Further, the Examiner rejected claims 9-10 under 35 U.S.C. § 103 as being unpatentable over Russell in view of Redford et al. (US Patent 5,459,489) (hereinafter "Redford"); and rejected claim 15 under 35 U.S.C. § 103 as being unpatentable over Russell in view of Colgan et al (US Patent 6,529,189). Applicants respectfully traverse these rejections.

### **Claim Rejections – 35 U.S.C. §102**

In their previous reply, Applicants argued that Russell failed to teach or suggest all of the elements of claim 11, including "varying the infrared signal in response to a user input related to **a frequency of use of pressure levels** and in response to changes in pen pressure against the display." Applicants argued that the signal is varied in response to a user input related to a **frequency of use, not pressure levels**. Russell clearly discloses adjusting the pulse width based on the current number of receiver pulses.

In response to this argument, the Examiner asserts that claim language requires the "varying" to be "related" to the "frequency of use" and to be in response to change in the pen pressure against the display. The Examiner asserts that the claim does not distinguish between past and present use. Thus, the Examiner maintains that the "current number" taught in Russell is sufficient to anticipate the claim.

Applicants respectfully note In order to establish a *prima facie* case of anticipation under 35 U.S.C. § 102, the Examiner must provide a reference that teaches each element of the claim. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d (BNA) 913, 920 (Fed. Cir.), *cert. denied*, 493 U.S. 853, 107 L.Ed 2d 112, 110 S.Ct. 154 (1989).

Although the Examiner admits that the claim requires the varying to be in response to **changes in pen pressure**, the Examiner provides no additional support for this claim element.

As the Examiner has failed to properly consider all of the claim elements, Applicants respectfully submit that the Examiner has failed to establish *prima facie* anticipation by failing to properly consider all of the claim elements.

Further, as Applicants outlined in their previously filed reply, Russell merely discloses varying the pulse width based on the **frequency of received pulses**, not on the **change of pen pressure** against the display. Russell clearly discloses adjusting the pulse width based on the **current number** (or the current use) of receiver pulses. A current number is wholly insufficient to anticipate frequency of use. Applicants submit that adjusting power based on the number of receiver pulses received during a frame is insufficient to teach or suggest varying the signal based on frequency of use. At least for this reason, Applicants respectfully submit that claim 11 is not anticipated by Russell and it is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 12 and 14-15 are allowable for the reasons set forth above with regard to claim 11 at least based on their dependency on claim 11.

### **Claim Rejections – 35 U.S.C. §103**

Applicants further argued that the cited references failed to teach or suggest enabling inputs of **a series of pen pressure levels in an order of frequency of use**. Redford merely discloses utilizing the input from the two orientation sensors to determine the orientation, or tilt, of the pen. Applicants maintained that these teachings are wholly insufficient to teach or suggest pen pressure.

In response to this argument, the Examiner recites unrelated case law regarding a combination of the teachings of the references, not the failure of the references to teach the claim

elements, as Applicants argued. The Examiner, while admitting that Russell fails to teach or suggest this claim element, relies on the teachings of Redford to teach “a controller having a sequence input mode enabling inputs of a series of levels in an order of frequency of use.” However, this assertion fails to address Applicants’ argument that the cited references fail to teach or suggest enabling inputs of **a series of pen pressure levels in an order of frequency of use**. The Examiner further fails to address Applicants’ argument that Redford discloses varying the contact signal in proportion to the pressure level.

MPEP §706.02(j) clearly sets forth the Examiner’s requirements when asserting a rejection under 35 U.S.C. §103. MPEP §706.02(j) provides as follows:

**35 U.S.C. §103** authorizes a rejection where, to meet the claim, it is necessary to modify a single reference or to combine it with one or more other references. After indicating that the rejection is under 35 U.S.C. §103, the examiner should set forth in the Office action:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (B) the difference or differences in the claim over the applied reference(s),
- (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
- (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

It is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply.

As previously argued on the record, Applicants maintain that claim 9 requires a controller having a sequence input mode enabling inputs of a series of pen pressure levels in an order of frequency of use. Redford does not disclose enabling inputs of a series of pen pressure levels in an order of frequency of use. Redford merely discloses utilizing the input from the two orientation sensors to determine the orientation, or tilt, of the pen. The teachings relied upon by the Examiner are wholly insufficient to teach or suggest pen pressure. Further, the Examiner's assertions that Redford discloses varying the contact signal in proportion to the pressure level, is wholly inaccurate for the reasons of record.

As such, Applicants respectfully submit that Redford fails to cure the deficiencies of the teachings of Russell by failing to teach or suggest a controller having a sequence input mode enabling inputs of a series of pen pressure levels in an order of frequency of use, as required by claim 9. As neither of the cited references teach or suggest this claim element, Applicants submit that claim 9 is not obvious over the references as cited and it is respectfully requested that the outstanding rejections be withdrawn.

The Examiner responds to Applicants' arguments in support of patentability regarding claim 10 by relying on his reasoning to support his rejection of claim 9. However, as noted on the record with regard to claim 9, Redford merely discloses two orientation sensors that receive the pulse width modulated square wave. Based on the signal received from the two orientation sensors, the tilt of the pen may be determined.

However, claim 10 requires the infrared transmitter sending a signal that varies with the sensed contact pressure between the input pen and the display device in a manner determined by a sequence input of a user. There is no disclosure that is directed to **varying the signal in a manner determined by a sequence input of a user.**

Further, as noted above with regard to claim 11, there is no disclosure in Russell that is directed to varying the signal based on the sensed contact pressure in a manner determined by a sequence input of a user. As neither of the cited references teach or suggest this claim element,

Applicants submit that claim 10 is not obvious over the references as cited. It is respectfully requested that the outstanding rejections be withdrawn.

As such, Applicants maintain that the claims as pending are patentable over the references as cited.

### **Conclusion**

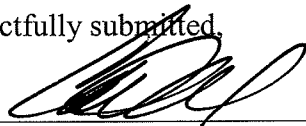
In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisin Reg. No. 52,327 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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